



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,399	02/15/2002	Shinichi Matsumoto	03500.016189	7211
5514	7590	07/27/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ALAM, SHAHID AL	
			ART UNIT	PAPER NUMBER

2162

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/075,399

Applicant(s)

MATSUMOTO, SHINICHI

Examiner

Shahid Al Alam

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on RCE 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 5, 7 - 10, 12 - 13, 17 and 25 - 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 5, 7 - 10, 12 - 13, 17 and 25 - 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1, 3 – 5, 7 – 10, 12 – 13, 17 and 25 – 28 are pending in this Office action.

#### *Claim Objections*

2. Claim 1, 3 – 5, 7, 9 – 10, 13, 17 and 25 – 28 objected to because of the following informalities: it is unclear whether the limitation “A personal assistant device” is a mechanical device or a computer implemented device or a computer generated device.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3 – 5, 7 – 10, 12 – 13 and 17 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

#### **MPEP 2106 IV.B.2.(b)**

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claims 1, 3 – 5, 7 – 10, 12 – 13 and 17, in view of the above-cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. **The use of a computer has not been indicated.**

Art Unit: 2162

These claim do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. **The use of a computer is not evident in the claim.** MPEP 2106.IV.B.1(a) refers to "computer-readable" medium with computer program encoded on it."

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 – 5, 7 – 10, 12 – 13, 17 and 25 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,774,803 issued to Kazuo Kariya ("Kariya") and in view of U.S. Patent Number 6,321,158 issued to David DeLorme et al. ("DeLorme").

With respect to claims 1, 13, 25 and 27, Kariya teaches a personal assistant (PA) device for receiving service information from a service information distribution device (see abstract), comprising:

a sending unit adapted to send position information of the PA device to the service information distribution device to be added to a history database managed by the service information distribution device (column 6, lines 40 – 48); and

a receiving unit adapted to receive the service information selected by the service information distribution device (column 7, lines 6 – 11),

wherein the service information distribution device selects a PA device to which the service information should be distributed on the basis of the history database in which the position information sent by said sending unit is reflected (column 2, lines 49 – 56, column 3, lines 11 – 15 and 39 – 45).

Kariya teaches claimed invention substantially as claimed including regional information and zone information. Kariya does not explicitly teach the position information of the personal assistant device as claimed.

DeLorme discloses claimed use information includes positional information of said personal assistant device (column 14, lines 41 – 45 and Fig 1A4).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine DeLorme with Kariya to provide a new integrated routing/mapping information system (IRMIS) capable of enabling the mating and cooperation between desktop and handheld devices, including the automatic updating of related database whenever the desktop PC and handheld PDA link together (column 4, lines 21 – 26; DeLorme).

As to claim 3, sends the position information in response to a request from the service information distribution device (column 2, lines 62 – 66).

As to claim 4, displaying the service information received by said receiving means (column 3, lines 11 – 15).

With respect to claim 5, 17, 26 and 28, Kariya teaches a service information distribution device for distributing service information to a personal digital assistant device (see abstract), comprising:

receiving means for receiving use information of a user intermittently from said personal digital assistant device (column 3, lines 3 – 13);

storing means for storing the received use information in a history database as history data (column 3, lines 39 – 43).

Kariya teaches claimed invention substantially as claimed including for receiving use information of a user intermittently (periodically) from said personal digital assistant device. Kariya also teaches a regional information center for transmit (distribute) information (see column 2, lines 49 – 56). Kariya does not explicitly teach selecting service information to be distributed to said personal digital assistant device as claimed.

DeLorme discloses claimed selection means for selecting service information to be distributed to said personal digital assistant device on the basis of the use information stored in said history database; and distribution means for distributing the service information selected by said selection means to said personal digital assistant device (column 6, lines 50 – 63; DeLorme).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine DeLorme with Kariya to provide a new integrated routing/mapping information system (IRMIS) capable of enabling the mating and cooperation between desktop and handheld devices, including the automatic updating of related database whenever the desktop PC and handheld PDA link together (column

Art Unit: 2162

4, lines 21 – 26; DeLorme). Since, Kariya's database of the regional information center serves a plurality of base station, it would have been obvious to combine to simplify the management and to reduce the cost of the regional information system (see column 8, lines 9 – 12; Kariya).

As to claim 7, selection unit selects the PA device to which the service information should be distributed on the basis of frequency of dropby of each zone by each PA device (column 2, lines 53 – 62; Kariya).

As to claim 8, the service information includes congestion degree information (column 1, lines 59 – 61 and column 3, lines 21 – 28; Kariya).

As to claim 9, the service information includes at least one of information regarding sale of an article, advertisement distribution, reservation, hall guidance, opening of an event and an attraction, suitable for said personal assistant device (column 5, lines 8 – 11; DeLorme).

As to claim 10, distributes the selected service information in response to request from said personal assistant device (column 6, lines 50 – 53; DeLorme).

As to claim 12, history database also stores accounting information for the user (column 2, lines 17 – 28; Kariya).


Art Unit: 2162

***Contact Information***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shahid Al Alam  
Primary Examiner  
Art Unit 2162

23 July 2005